



### REMARKS

The following remarks are made in response to the Office Action mailed March 4, 2005. Claims 1-20 were rejected. Claims 1, 9, 11, 14, 15, 18, and 19 have been amended. Claims 1-20 remain pending in the application and are presented for reconsideration and allowance.

#### Claim Rejections under 35 U.S.C. § 102

Claims 1-20 are rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 6,002,868 ("Jenkins").

Claim 1 recites, *inter alia*:

a first expansion slot coupled to the first I/O controller; and  
a test module card directly coupled to the first expansion  
slot;  
wherein the test module card is configured to cause tests to  
be performed on the memory using direct memory access (DMA).

Jenkins does not teach or suggest "a test module card directly coupled to the first expansion slot" as recited in claim 1. The Office Action cites column 1, lines 31-32 of Jenkins as a teaching or suggestion of this feature of claim 1. At column 1, lines 31-32, Jenkins teaches "[a] specific module is provided to test each device." This portion of Jenkins does not teach or suggest "a test module card directly coupled to the first expansion slot" as recited in claim 1.

Jenkins appears to teach a "hard disk drive 124" that contains a "diagnostic application 150" rather than a "test module card" as recited in claim 1. See, e.g., column 3, line 67 to column 4, line 2 and Figure 1. Jenkins also teaches PCI slots 120 and ISA slots 138. See Figure 1. Jenkins does not teach or suggest that the diagnostic application 150 is directly coupled to PCI slots 120 or ISA slots 138. Accordingly, Jenkins does not teach or suggest "a test module card directly coupled to the first expansion slot" as recited in claim 1.

In addition, Jenkins does not teach or suggest "wherein the test module card is configured to cause tests to be performed on the memory using direct memory access (DMA)" as recited in claim 1. The Office Action cites column 3, lines 55-57 of Jenkins as a teaching or suggestion of this feature of claim 1. At column 3, lines 55-57, Jenkins teaches that "[t]he PCI-to ISA bridge 122 integrates many of the common ISA peripherals, such as a DMA (Direct Memory Access) Controller ... ." This portion of Jenkins only identifies the existence of a DMA controller and

does not teach or suggest “wherein the test module card is configured to cause tests to be performed on the memory using direct memory access (DMA)” as recited in claim 1. Further, Jenkins does not appear to teach or suggest that diagnostic application 150 is “is configured to cause tests to be performed on the memory using direct memory access (DMA)” as recited in claim 1.

As described above, Jenkins does not teach or suggest “a test module card directly coupled to the first expansion slot” or “wherein the test module card is configured to cause tests to be performed on the memory using direct memory access (DMA)” as recited in claim 1. Accordingly, Applicants respectively submits that claim 1 patentably distinguishes over Jenkins for at least these reasons. Claims 2-8 depend from claim 1 and are believed to patentably distinguish over the cited references for at least the above reasons. Accordingly, Applicants respectfully request the withdrawal of the rejection of claims 1-8 under 35 U.S.C. §102(b).

In addition, claim 6 recites “wherein the read and write transactions comprise DMA transactions”. The Office Action cites column 3, line 56 of Jenkins as a teaching or suggestion of this feature of claim 6. At column 3, lines 55-57, Jenkins teaches that “[t]he PCI-to ISA bridge 122 integrates many of the common ISA peripherals, such as a DMA (Direct Memory Access) Controller ... .” This portion of Jenkins only identifies the existence of a DMA controller and does not teach or suggest “wherein the read and write transactions comprise DMA transactions” as recited in claim 6. Accordingly, Applicants respectively submits that claim 6 patentably distinguishes over Jenkins for at least this additional reason.

Claim 9 recites, *inter alia*:

selecting a portion of a memory of a computer system for testing during operation of the computer system;  
generating a test transaction in a test module card directly coupled to an expansion slot of the computer system; and  
providing the test transaction to the portion using direct memory access (DMA).

Jenkins does not teach or suggest “generating a test transaction in a test module card directly coupled to an expansion slot of the computer system” as recited in claim 9. As described above with reference to claim 1, Jenkins appears to teach a “hard disk drive 124” that contains a “diagnostic application 150” rather than a “test module card” as recited in claim 1. See, e.g., column 3, line 67 to column 4, line 2 and Figure 1. Jenkins also teaches PCI slots 120 and ISA slots 138. See Figure 1. Jenkins does not teach or suggest that the diagnostic application 150 is

directly coupled to PCI slots 120 or ISA slots 138. Accordingly, Jenkins does not teach or suggest “generating a test transaction in a test module card directly coupled to an expansion slot of the computer system” as recited in claim 9.

In addition, Jenkins does not teach or suggest “providing the test transaction to the portion using direct memory access (DMA)” as recited in claim 9. Similar to the rejection of claim 1 above, the Office Action cites column 3, lines 55-57 of Jenkins as a teaching or suggestion of this feature of claim 9. At column 3, lines 55-57, Jenkins teaches that “[t]he PCI-to ISA bridge 122 integrates many of the common ISA peripherals, such as a DMA (Direct Memory Access) Controller ... .” This portion of Jenkins only identifies the existence of a DMA controller and does not teach or suggest “providing the test transaction to the portion using direct memory access (DMA)” as recited in claim 9. Further, Jenkins does not appear to teach or suggest that diagnostic application 150 “provid[es] the test transaction to the portion using direct memory access (DMA)” as recited in claim 9.

As described above, Jenkins does not teach or suggest “generating a test transaction in a test module card directly coupled to an expansion slot of the computer system” or “providing the test transaction to the portion using direct memory access (DMA)” as recited in claim 9. Accordingly, Applicants respectfully submit that claim 9 patentably distinguishes over Jenkins for at least these reasons. Claims 10-14 depend from claim 9 and are believed to patentably distinguish over the cited references for at least the above reasons. Accordingly, Applicants respectfully request the withdrawal of the rejection of claims 9-14 under 35 U.S.C. §102(b).

Claim 15 recites, *inter alia*:

an expansion slot coupled to the I/O controller; and  
a test module card directly coupled to the expansion slot;  
wherein the test module card is configured to cause tests to  
be performed on the memory by providing read transactions  
associated with the memory to the I/O controller.

Jenkins does not teach or suggest “a test module card directly coupled to the first expansion slot” as recited in claim 15. Similar to the rejection of claim 1 above, the Office Action cites column 1, lines 31-32 of Jenkins as a teaching or suggestion of this feature of claim 1. At column 1, lines 31-32, Jenkins teaches “[a] specific module is provided to test each device.” This portion of Jenkins does not teach or suggest “a test module card directly coupled to the expansion slot” as recited in claim 15.

As described above with reference to claim 1, Jenkins appears to teach a “hard disk drive 124” that contains a “diagnostic application 150” rather than a “test module card” as recited in claim 15. See, e.g., column 3, line 67 to column 4, line 2 and Figure 1. Jenkins also teaches PCI slots 120 and ISA slots 138. See Figure 1. Jenkins does not teach or suggest that the diagnostic application 150 is directly coupled to PCI slots 120 or ISA slots 138. Accordingly, Jenkins does not teach or suggest “a test module card directly coupled to the expansion slot” as recited in claim 15.

Accordingly, Applicants respectfully submits that claim 15 patentably distinguishes over Jenkins for at least these reasons. Claims 16-20 depend from claim 15 and are believed to patentably distinguish over the cited references for at least the above reasons. Accordingly, Applicants respectfully request the withdrawal of the rejection of claims 15-20 under 35 U.S.C. §102(b).

In addition, claim 19 recites “wherein the test module card is configured to cause tests to be performed on the memory using direct memory access (DMA)”. Similar to the rejection of claim 1 above, the Office Action cites column 3, lines 55-57 of Jenkins as a teaching or suggestion of this feature of claim 19. At column 3, lines 55-57, Jenkins teaches that “[t]he PCI-to ISA bridge 122 integrates many of the common ISA peripherals, such as a DMA (Direct Memory Access) Controller . . . .” This portion of Jenkins only identifies the existence of a DMA controller and does not teach or suggest “wherein the test module card is configured to cause tests to be performed on the memory using direct memory access (DMA)” as recited in claim 19. Further, Jenkins does not appear to teach or suggest that diagnostic application 150 is “is configured to cause tests to be performed on the memory using direct memory access (DMA)” as recited in claim 19. Accordingly, Applicants respectfully submits that claim 19 patentably distinguishes over Jenkins for at least this additional reason.

### **CONCLUSION**

In view of the above, Applicants respectfully submit that pending claims 1-20 are in form for allowance and are not taught or suggested by the cited references. Therefore, reconsideration and withdrawal of the rejections and allowance of claims 1-20 is respectfully requested.

The Examiner is invited to contact the Applicants’ representative at the below-listed telephone numbers to facilitate prosecution of this application.

Any inquiry regarding this Amendment and Response should be directed to either David A. Plettner at Telephone No. (408) 447-3013, Facsimile No. (408) 447-0854 or Christopher P. Kosh at Telephone No. (512) 231-0533, Facsimile No. (512) 231-0540. In addition, all correspondence should continue to be directed to the following address:

**Hewlett-Packard Company**  
Intellectual Property Administration  
P.O. Box 272400  
Fort Collins, Colorado 80527-2400

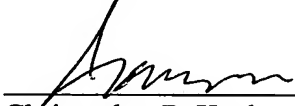
Respectfully submitted,

Andrew H. Barr et al.,

By their attorneys,

DICKE, BILLIG & CZAJA, PLLC  
Fifth Street Towers, Suite 2250  
100 South Fifth Street  
Minneapolis, MN 55402  
Telephone: (612) 573-2000  
Facsimile: (612) 573-2005

Date: 6/7/05  
CPK/dmd

  
Christopher P. Kosh  
Reg. No. 42,760

CERTIFICATE UNDER 37 C.F.R. 1.8: The undersigned hereby certifies that this paper or papers, as described herein, are being deposited in the United States Postal Service, as first class mail, in an envelope address to: Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 3rd day of June, 2005.

By   
Name: Denyse Dauphinais